

REMARKS

Applicant submits this Request for Reconsideration in reply to the Office Action mailed on March 23, 2006. Claims 1, 2, and 5-25 are currently pending. Claims 1, 6, 7, 8, 16, and 17 are independent.

On pages 2-8 of the Office Action, the Examiner rejects claims 1, 2, 5-8, 10, 12, 14, and 16-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,351,745, issued to Itakura et al. ("Itakura"), in view of U.S. Patent Application Publication No. 2005/0188328, to Sezan et al. ("Sezan"). On pages 8-9 of the Office Action, the Examiner rejects claims 9, 11, 13, and 15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Itakura and Sezan, and further in view of U.S. Patent No. 6,282,713, issued to Kitsukawa et al. ("Kitsukawa"). Applicant respectfully traverses these rejections, for at least the reasons stated below.

I. 35 U.S.C. § 103(a): Independent Claims

As M.P.E.P. § 2142 states, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143

(8th ed. 2001). Here, the combination of Itakura and Sezan fails to disclose each and every limitation of the independent claims, and thus the rejection of claims 1, 2, 5-8, 10, 12, 14, and 16-25 in view of Itakura and Sezan is improper. Furthermore, there would be no motivation to combine the features taught by Sezan with the system of Itakura.

Itakura describes a system for distributing advertisements over the Internet. The system provides a display that includes a message viewer 76 having a message viewer window 62 (presumably for advertisements), and a browser 74 having an Internet browser window 60. See col. 9, lines 14-23 and Figure 4. The system of Itakura allows a URL stored in a URL database (transmittal condition database 36) to be selected using information stored in a user database (message user database 34) and delivered to the message viewer 76. See col. 10, lines 48-58. An advertisement stored at the URL may then be sent to the message viewer window 62 (see col. 12, lines 1-14), and may contain data which represents a home page address of a store on the WWW (see col. 8, lines 1-7). A "home page" button 64 in the message viewer 76 may then be selected to open the home page in the browser 74. See col. 9, lines 14-23. The advertisements disclosed by Itakura may be still images, dynamic images, sound images, or combinations thereof. See col. 8, lines 4-8.

Sezan discloses a system for storing and providing access to image, video, and/or audio information. See p. 3, paragraph 42. The system stores information about video, still image, and/or audio information to allow users to search, filter, and access the video, audio, and/or still image information in varying detail amounts. Id. The stored information may include segment information related to video sequences, or texture or color descriptors related to still images. See p. 16, paragraph 188.

In contrast to Itakura and Sezan, claim 1 recites, *inter alia*:

An information processing apparatus for delivering contents data via a network to other apparatus, comprising:

first registration means for registering general additional information regarding said contents data...

second registration means for registering individual additional information of said contents data on the basis of at least said contents data,

wherein said individual additional information comprises overall individual additional information which is associated with the contents data as a whole, segment individual additional information which is associated with one of a plurality of segments of the contents data, and scene individual additional information associated with one of a plurality of scenes in contents data... and

transmission means for transmitting said contents data and said individual data generated by said generation means via said network to said other apparatus, to enable said contents data, said general additional information, and said individual additional information to be simultaneously displayed on a display screen at said other apparatus;

whereby contents data is delivered together with extracted general additional information and extracted individual additional information in response to a request for usage generated by said other apparatus....

First, the Examiner concedes that Itakura does not disclose or suggest: "said individual additional information comprises overall individual additional information which is associated with the contents data as a whole, segment individual additional information which is associated with one of a plurality of segments of the contents data, and scene individual additional information associated with one of a plurality of scenes in contents data." Office Action at p. 5, lines 1-6. The Examiner instead relies on Sezan and asserts:

"It clearly would have been obvious for one skilled in the art at the time to modify Itakura with teaches [sic] 'segment individual additional information which is associated with one of a plurality of segments of the contents data and scene individual additional information associated with one of a plurality of scenes in contents data' [to efficiently determine content of potential interest to the user]."

Applicant respectfully disagrees with this assertion. Itakura does not disclose any scene information or segment information. Instead, Itakura only discusses advertisements comprising “still images, dynamic images, sound images or combinations thereof.” See Itakura, col. 8, lines 4-8. There would be no reason to register segment individual additional information which is associated with one of a plurality of segments of contents data and scene individual additional information associated with one of a plurality of scenes in contents data in the system taught by Itakura, because Itakura does not contemplate scene or segment content. Therefore, the Examiner’s statement describing a general motivation for including the features allegedly taught by Sezan in the system of Itakura is not sufficient to satisfy 35 U.S.C. § 103(a) and appears to be made with improper hindsight.

Second, in addressing the claim limitation of enabling “said contents data, said general additional information, and said individual additional information to be simultaneously displayed on a display screen at said other apparatus,” the Examiner takes “official notice” that “it was well known in the art at the time of the invention for said contents data, said general additional information and said individual additional information to be simultaneously displayed on a display screen where contents data is delivered together with extracted information.” Applicant respectfully disagrees that this was well known at the time of the invention. Applicant traverses the Examiner’s taking of Official Notice, and requests that if the rejection is to be maintained, that the Examiner supply a reference showing the missing features of the claimed invention.

Third, the Examiner has failed to address the claim language as a whole, and has improperly interpreted certain claim terms differently within the same claim. For the

rejection under 35 U.S.C. § 103(a) to be proper, the claimed invention must be considered as a whole and the cited art must teach or suggest all limitations of the claims. See M.P.E.P. § 2141(II) (8th Ed. October 2005).

In the Office Action, the Examiner first interprets “registering general additional information” as storing “data which represents the location of the data requested,” such as a home page address of a store on the world wide web (e.g., a URL). The Examiner then interprets “registering individual additional information” as registering “client preferences,”¹ such as “sex, marriage status, occupation,” or “goods that the user has already shown an interest in.” Office Action at p. 3, lines 10-17. However, claim 1 further recites “extracting said general additional information,” “[extracting] said individual additional information,” and delivering “contents data... together with extracted general additional information and extracted individual additional information.” Itakura fails to disclose at least this last delivering step, in the context of the claim. Itakura only delivers advertisements (interpreted by the Examiner as “content data”), possibly with URLs (interpreted by the Examiner as “general additional information”). But under this interpretation or under any reasonable interpretation of the claim language, Itakura does not disclose delivering advertisements (i.e. “contents data”) together with extracted URLs (i.e. “general additional information”) *and* extracted general individual information (i.e. user information such as sex, marriage, occupation, etc., according to the Examiner’s claim interpretation). As such, the Examiner has failed to show that the cited art discloses all of the claim limitations, and has thus failed to establish a *prima facie* case of obviousness.

Accordingly, the cited art does not support the rejection of claim 1. Therefore, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn and the claim allowed.

Independent claims 6, 7, 8, 16, and 17, although of different scope, include similar distinguishing features as discussed above in connection with claim 1. As explained, claim 1 is distinguishable from the cited art. Accordingly, the cited art does not support the rejection of claims 6, 7, 8, 16, and 17 for at least the same reasons set forth above in connection with claim 1. Therefore, the rejection of claims 6, 7, 8, 16, and 17 under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed.

II. 35 U.S.C. § 103(a): Dependent Claims

Applicant further submits that claims 2, 5, 9-15, and 18-25 each depend from one of independent claims 1, 6, 7, 8, or 17 and are therefore allowable for at least the same reasons that independent claims 1, 6, 7, 8, and 17 are allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited references, and therefore are also separately patentable.

In addition, regarding claims 18, 19, and 21-25, the Examiner failed to address these claims in the Office Action, instead merely stating, "With respect to claims 18-25, are by the limitations addressed for claim 1 (by virtue of the alternative language)". Applicant does not understand this statement. Claims 18-25 present additional recitations that are not recited in claim 1. For example, claim 18 recites that "said general additional information" comprises "the time or date of filming a video scene of

1 Note: Itakura does not disclose "client preferences" or "user preferences." The

said contents data.” This feature is not disclosed in any of the cited art, and the Examiner has failed to explain to the contrary. For at least these additional reasons, the rejection of claims 18, 19, and 21-25 should be withdrawn and the claims allowed.

III. Conclusion

In view of the foregoing remarks, this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of pending claims 1, 2, and 5-25.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and drawings in this Request for Reconsideration, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

If a telephone interview will expedite issuance of this application, the Examiner is requested to call Applicants' representative, whose name and registration number appear below, to discuss any remaining issues.

Examiner's use of those terms in discussing Itakura is therefore misplaced.

Please grant any extensions of time required to enter this Request for
Reconsideration and charge any additional required fees to our Deposit Account No.
06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 16, 2006

By: Bradley Edelman
Bradley Edelman
Reg. No. 57,648

Attachments: None